

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANK S. ELLIOTT

Appeal No. 2001-1355
Application No. 09/110,348

ON BRIEF

Before McQUADE, NASE and BAHR, Administrative Patent Judges.
McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Frank S. Elliott appeals from the final rejection (Paper No. 15) of claims 1 through 5, 7 through 9 and 11, all of the claims pending in the application.

THE INVENTION

The invention relates to a "portable apparatus for cooling and heating air in a room or the like and, more particularly, to the cooling of air by using ice and ice water

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for cooling through a heat exchanger" (specification, page 1).

Representative claim 1 reads as follows:

1. Apparatus for cooling an area comprising in combination:

housing means for holding a quantity of liquid cooling medium including an insulated wall, a bottom wall, and a rim;

a support wall disposed on the rim of the housing means and removable for adding the liquid cooling medium to the housing;

a liquid cooling medium in the housing means below the support wall;

a heat exchanger disposed on the support wall above the liquid cooling medium;

pump means for pumping the liquid cooling medium to the heat exchanger;

means for circulating air through the heat exchanger and to the area to be cooled; and

a top closing the housing means and disposed on the support wall and the housing means and enclosing the heat exchanger and the means for circulating air, and removable with the support wall for adding the liquid cooling medium to the housing.

THE PRIOR ART

The references relied on by the examiner as evidence of obviousness are:

Karge	2,198,822	Apr. 30, 1940
MacCracken	2,885,189	May 5, 1959
Little	4,821,354	Apr. 18, 1989

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THE REJECTIONS

Claims 1 through 5, 7 and 8 stand rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellant regards as the invention.

Claims 1 through 5, 7 through 9 and 11 stand rejected under 35 U.S.C. § 112, first paragraph, as being based on a specification that fails to comply with the written description requirement of this section of the statute.

Claims 1 through 4 and 7 through 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Karge in view of MacCracken.

Claims 5 and 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Karge in view of MacCracken and Little.

Attention is directed to the appellant's brief (Paper No. 19) and to the examiner's answer (Paper No. 20) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.

DISCUSSION

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I. The 35 U.S.C. § 112, second paragraph, rejection of claims
1 through 5, 7 and 8

We shall summarily sustain this rejection inasmuch as the appellant has not challenged the examiner's contention that claims 1 through 5, 7 and 8 are indefinite due to a lack of proper antecedent basis for the term "the housing" in parent claim 1.

II. The 35 U.S.C. § 112, first paragraph (written
description), rejection of claims 1 through 5, 7 through 9 and
11

This rejection rests on the examiner's determination that "[r]egarding claims 1 and 9, the originally filed specification failed to disclose a removable support wall and a top/dome removable with the support wall" (answer, page 3). As indicated above, independent claim 1 recites a cooling apparatus comprising, inter alia, a removable support wall disposed on the rim of the housing means and a top disposed on the support wall and removable with the support wall for adding liquid cooling medium to the housing (means). Independent claim 9, which recites a dome instead of a top, contains similar limitations.

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The test for compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). The content of the drawings may also be considered in determining compliance with the written description requirement. Id.

Although the appellant's original disclosure does not expressly describe the support wall 50 or the top/dome 30, 32, as being removable from the housing 12, it stands to reason that these elements are necessarily removable to allow ice blocks 90 to be placed in the housing. The recitation that the top or dome is removable "with" the support wall merely signifies that both elements are removable, and not, as implied by the examiner, that they are somehow structurally interrelated for joint removal. Thus, the disclosure of the application as originally filed would reasonably convey to the artisan that

the appellant had possession at that time of a cooling apparatus comprising a removable support wall and top/dome as recited in independent claims 1 and 9.

Accordingly, we shall not sustain the standing 35 U.S.C. § 112, first paragraph, rejection of claims 1 and 9, or of dependent claims 2 through 5, 7, 8 and 11.

III. The 35 U.S.C. § 103 of claims 1 through 4 and 7 through 9 as being unpatentable over Karge in view of MacCracken

Karge, the examiner's primary reference, discloses "an apparatus that melts ice for the purpose of air conditioning or cooling and drying the atmosphere of a room" (page 1, column 1, lines 1 through 4). As shown in Figures 1 through 3, the apparatus includes an ice chest 1 having a side access door 2, blocks of ice 4-8 within the chest, tanks 10 and 12 for receiving and holding cold water derived from the ice, pumps 19 and 25 for drawing water from the respective tanks, and a fan and air conditioning unit housing 22 having a support wall mounting coils 21 and 28 for receiving cold water from the pumps and a fan 43 for moving air into housing 22, through the coils and out through a grille 44 into the surrounding room.

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As conceded by the examiner (see pages 4 and 5 in the answer), the Karge apparatus does not meet the limitations in claims 1 and 9 requiring the support wall to be removably disposed on the rim of the housing means and the top/dome to be disposed on and removable with the support wall for adding liquid cooling medium (water and ice) to the housing means.

MacCracken discloses a personal thermal device "in which liquid is circulated through a flexible panel for supplying heat to or carrying heat away from a person's body" (column 1, lines 17 through 19). The device includes a circulator 14 which communicates with the flexible panel 10 through a pair of flexible tubes 12. The circulator comprises a container 22 for holding the cooling/heating liquid, a removable threaded cover 26 which allows the container to be filled or recharged with the liquid, a pump 28 mounted on the cover for circulating the liquid between the container and the flexible panel, and a protective hood 31 carried by the cover.

In proposing to combine Karge and MacCracken to reject independent claims 1 and 9 (see pages 4 and 5 in the answer), the examiner concludes that it would have been obvious in view

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of MacCracken's disclosure of a removable top (hood 31) and support wall (cover 26) on the rim of a housing (container 22) to employ a similar arrangement in the Karge apparatus to facilitate replacing or installing the cooling medium.

Obviousness cannot be established by combining prior art absent some teaching or suggestion supporting the combination; in other words, the mere fact that prior art may be modified in a manner proposed by an examiner would not have made the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The proposed combination of Karge and MacCracken would involve a complicated and extensive reconstruction of the Karge apparatus beginning with the placement of the air conditioning and fan unit housing 22 over the ice chest 1. The alleged incentive for this dubious change, to facilitate the installation or replacement of the cooling medium, does not stand up in view of Karge's side access door 2 which would be far superior to the removable support wall and top/dome embodied by the proposed modification in terms of easy addition and replacement of the cooling medium. In this

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light, it is apparent that the only suggestion for combining Karge and MacCracken so as to arrive at the invention set forth in claims 1 and 9 stems from hindsight knowledge impermissibly derived from the appellant's disclosure.

Accordingly, we shall not sustain the standing 35 U.S.C. § 103 rejection of independent claims 1 and 9, and dependent claims 2 through 4, 7 and 8, as being unpatentable over Karge in view of MacCracken.

As Little's disclosure of a portable cooling mat assembly comprising a submersible pump does not cure the foregoing deficiency in the basic Karge-MacCracken combination, we also shall not sustain the standing 35 U.S.C. § 103 rejection of claims 5 and 11 as being unpatentable over Karge in view of MacCracken and Little.

SUMMARY

The decision of the examiner:

- a) to reject claims 1 through 5, 7 and 8 under 35 U.S.C. § 112, second paragraph, is affirmed;
- b) to reject claims 1 through 5, 7 through 9 and 11 under 35 U.S.C. § 112, first paragraph, is reversed;

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c) to reject claims 1 through 4 and 7 through 9 under 35 U.S.C. § 103 as being unpatentable over Karge in view of MacCracken is reversed; and

d) to reject claims 5 and 11 under 35 U.S.C. § 103 as being unpatentable over Karge in view of MacCracken and Little is reversed.

No period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

JOHN P. McQUADE)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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AFFIRMED-IN-PART

June 13, 2002